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Paper No. 7

Supervisor, Patent Prosecution Services
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1200 Nineteenth Street, N. W.
Washington, DC 20036-2412

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OFFICE OF PETITIONS

In re Application of	:	
Duncan W. McBranch, et al.	:	
Application No. 09/934,680	:	ON PETITION
Filed: August 23, 2001	:	
Attorney Docket No. 8971-017-27	:	

This is in response to the petition under 37 CFR 1.47(a), filed March 28, 2002.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** Any extensions of time will be governed by 37 CFR 1.136(a).

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. Applicant lacks item (1) set forth above.

Petitioner alleges that Michael Egholm refuses to sign the declaration that was twice sent to him. Petitioner has supplied a copy of an e-mail message from Mr. Egholm to David Whitten, the second named inventor, acknowledging receipt of the declaration and assignment. In the e-mail message, Mr. Egholm states he wants to contact Mr. Andy Karnakis, an attorney for Tropix, Inc., to determine if he is able to sign the declaration. According to statements presented in the instant petition, Petitioner contacted Mr. Karnakis who did recall the situation concerning the

declaration and assignment for Mr. Egholm but "could not recall his instructions to Mr. Egholm regarding the same."

Although it is obvious that Mr. Egholm received the declaration and assignment, it is unclear whether Mr. Egholm received a copy of the application papers. MPEP 409.03(d) in pertinent part states:

"Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings and oath or declaration) to the non-signing inventor for signature. A copy of the application papers should be sent to the last known address of the non-signing inventor, or if the non-signing inventor is represented by counsel, to the address of record of the non-signing inventor's attorney."

Petitioner must supply a copy of the application papers to Mr. Egholm as required. Upon the filing of a Request for Reconsideration, petitioner must demonstrate that a *bona fide* attempt was made to present the application papers (specification, including claims, drawings and oath or declaration) to the non-signing inventor. If there is an express written refusal to sign the declaration, a copy of the document evidencing that refusal should be submitted to the USPTO. If the non-signing inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration and any documentary evidence to support facts alleged in the affidavit or declaration should be submitted with the reconsideration request.

Further correspondence with respect to this matter should be addressed as follows:

By MAIL: Assistant Commissioner for Patents
P. O. Box 2327, Mail Stop DAC
Arlington, VA 22202

or

Assistant Commissioner for Patents
Box DAC
Washington, DC 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By HAND: 2201 South Clark Place
Crystal Plaza 4, Suite 3C23
Arlington, VA 22202

Telephone inquiries regarding this decision should be directed to Marianne Morgan at (703) 306-3475.

A handwritten signature in cursive script that reads "Frances Hicks".

Frances M. Hicks

Lead Petitions Examiner

Office of Petitions

Office of the Deputy Commissioner
for Patent Examination Policy